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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/393,579	09/09/1999	STEVE DE KECZER	IR98-7410	2931

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EXAMINER

CELSA, BENNETT M

ART UNIT PAPER NUMBER

1627

DATE MAILED: 05/03/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

file  
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## Advisory Action

Application No. <b>09/393,579</b>	Applicant(s) <b>De Keczer et al.</b>
Examiner <b>Bennett Celsa</b>	Art Unit <b>1627</b>



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Apr 4, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

### THE PERIOD FOR REPLY [check only a) or b)]

a)  The period for reply expires six months from the mailing date of the final rejection.

b)  In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.  A Notice of Appeal was filed on \_\_\_\_\_ . Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2.  The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3.  The proposed amendment(s) will not be entered because:
  - (a)  they raise new issues that would require further consideration and/or search. (See NOTE below);
  - (b)  they raise the issue of new matter. (See NOTE below);
  - (c)  they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d)  they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: See attached.

4.  Applicant's reply has overcome the following rejection(s):  
\_\_\_\_\_  
\_\_\_\_\_
5.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).
6.  The a)  affidavit, b)  exhibit, or c)  request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
\_\_\_\_\_
7.  The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8.  For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):  
Claim(s) allowed: \_\_\_\_\_  
Claim(s) objected to: \_\_\_\_\_  
Claim(s) rejected: 1, 14-16, 19, 21-30, 32, 33, and 37-44
9.  The proposed drawing correction filed on \_\_\_\_\_ a)  has b)  has not been approved by the Examiner.
10.  Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
11.  Other:

Art Unit: 1627

## **DETAILED ACTION**

### ***Advisory Action Cont.***

Applicant's After Final (paper no. 11) has been denied entry for the reasons recited on the front of the Advisory Action sheet and the following reasons:

- a. The amendment of the claims (e.g. claim 1,19,32,44 and dependent claims) reciting "alpha haloaldehyde") raises the issue of new matter.
- b. The amendment of the claims (e.g. claim 1,19,32,44 and dependent claims) reciting "alpha haloaldehyde") would require further search and/or consideration since this is addressed to new claim limitations which go beyond the elected BABA species.
- c. The amendment of the claims (e.g. claim 1,19,32,44 and dependent claims) reciting "alpha haloaldehyde") may require the revision of present rejections or the raising of new rejections directed to this non-elected subject matter.
- d. The amendment of the claims (e.g. claim 1,19,32,44 and dependent claims) to recite "derivatized with" and the additional language (e.g. "when under biological conditions .... protected functional group" would require:
  - new consideration and search
  - raise the issue of new matter;
  - require the modification of present indefinite rejection or raise a new rejection.
- e. There is no reason why this amendment was not earlier presented.

Art Unit: 1627

f. The after-final amendment for all the reasons recited above would not simplify the issues for appeal.

***Discussion***

In order to further advance the future prosecution of the present application the following comments addressing applicant's viewpoints expressed in the after-final are provided.

1. Regarding the restriction requirement, applicant's argument that BABA is not a "protected alkylating agent" would be more persuasive if applicant considered amending the claims ( e.g. claim 12) to be consistent with this argument and to elect a specific "protected" BABA, and perhaps draft a claim to the elected embodiment.
2. The former new matter rejection would appear to be withdrawn in light of applicant's proposed after-final. However, the same after-final re-raises the issue of new matter.
3. To the extent that applicant's proposed after-final claims still retain "capable of" and "unreactive" terminology; the outstanding indefinite rejection over these terms is maintained.
4. With regard to the indefinite rejection of the term "a protected alkylating agent", to the extent that this terminology is removed from the proposed claims; this aspect of the indefinite rejection of the claims has been overcome. However, applicant's proposed after-final fails to indicate *what "functional group"* is being "derivatized".
5. Amending to indicated what "functional group" is being modified (and how so modified vis a vis the protecting group) would serve to overcome the outstanding indefinite rejection regarding "modified" (e.g. homocysteine).

Art Unit: 1627

6. Applicant's proposed after-final amendment would overcome the anticipation rejection over the Metzger reference.

7. The anticipation rejection and the double patenting rejections over the Van Atta reference would not be overcome by the proposed after-final amendment. Arguments already rebutting applicant's arguments in the after-final have been recited during the prosecution of this case. Applicant's claim should consider the claim recitation of structure to distinguish over BABA and the ester derivatives (e.g. succinamide) described in the Van Atta reference.

**General information regarding further correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Celsa whose telephone number is (703) 305-7556.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat (art unit 1627), can be reached at (703)308-0570.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Bennett Celsa (art unit 1627)

April 29, 2002

BENNETT CELSA  
PRIMARY EXAMINER

